

Application No.: 09/821,480
Attorney Docket No. 05725.0777-00000

REMARKS

I. Status of Claims

Claims 1-40, 161, and 162 are pending in this application. Claims 41-120, 152-155, and 163 have been withdrawn from consideration. Claims 1 and 161 have been amended.

II. Rejection under 35 U.S.C. §112

Claims 1-40, 161, and 162 are rejected under 35 U.S.C. §112, as failing to comply with the written description requirement. *Office Action* at p. 2. Applicants respectfully traverse this rejection.

Claim 1 relates to a composition comprising at least one film forming agent with the proviso that the at least one film forming agent is not hydroxypropylmethylcellulose. The Examiner asserts that the proviso is new matter because the specification does not state "that the above polymers list exclude hydroxypropylmethylcellulose." *Id.* Applicants respectfully disagree and submit that *In re Johnson* permits exactly this type of proviso. *In re Johnson*, 558 F.2d 1008 (CCPA 1977).

The application at issue in *Johnson* ("the 1972 application") claimed priority to a parent "1963 application." *Id.* at 1009. The 1963 application described polyarylene polyethers comprising subunits E and E'. The written description issue focused on the precursor compounds to E and E'. The 1963 application generically described both types of precursor compounds and listed 50 specific E precursor compounds. *Id.* at

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1012. Additionally, twenty-six examples disclosed in detail fifteen specific polyarylene polyethers. *Id.*

The 1963 application was subject to an interference, which the appellants in *Johnson* lost. Subsequently, the 1972 application was filed to exclude the species of the lost count, as exemplified in claim 1 below:

1. A substantially linear thermoplastic polyarylene polyether composed of recurring units having the general formula:



where E is the residuum of a dihydric phenol and E' is the residuum of a benzenoid compound having an inert electron withdrawing group in one or more of the positions ortho and para to the valence bonds having a σ^* value above about 0.7 ... with the provisos that E and E' may not both include a divalent sulfone group and may not both include a divalent carbonyl group linking two aromatic nuclei.

Id. at 1013 (emphasis added). The provisos represent the lost count. As a result, fourteen of the species of polyarylene ethers and twenty-three of the examples remained within the claim scope. *Id.* at 1018.

Both the examiner and the Board found that the claims were not supported by the earlier 1963 application. *Id.* at 1014. The Board rationalized that appellants had created an "artificial subgenus," which was not described in the parent case. *Id.* Accordingly, the proviso was held to be "new matter ... for which no antecedent basis exists in the parent case." *Id.*

The CCPA disagreed. The Court determined that the 1963 application was "clearly directed" to the claimed polymers and noted the specific descriptions for E and

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E' as well as the twenty-three examples and fifteen species of polyarylene polyethers. *Id.* at 1018. Relying on the premise that "[i]t is for the inventor to decide what bounds of protection he will seek," the Court found that the appellants simply narrowed the claim scope to exclude the subject matter of the lost interference count":

Here, as we hold on the facts of this case, the "written description" in the 1963 specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining.

Id. at 1018, 1019 (emphasis added). Regarding the Board's requirement that the genus and proviso (the "artificial genus") be described in the 1963 application, the Court characterized this as a "hypertechnical application of legalistic prose" relating to the written description requirement. *Id.* at 1019. Accordingly, the Court reversed the Board's finding and found that the written description requirement was satisfied.

The present case presents the same facts. Applicants' specification describes film-forming agents and lists a number of examples. Applicants now wish to narrow the claim scope by excluding one agent, hydroxypropylmethylcellulose, which is disclosed in the specification by the Amendment of October 21, 2003. (See p. 6). Like *Johnson*, because the specification described film-forming agents ("the whole"), it necessarily described "the part remaining," *i.e.*, film forming agents minus hydroxypropylmethylcellulose.

Accordingly, Applicants respectfully request consideration of the law of *In re Johnson* and withdrawal of this rejection.

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III. Rejection under 35 U.S.C. §102

Claims 1-40, 161, and 162 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,660,838 ("Koga"). *Office Action* at p. 3. Applicants respectfully traverse this rejection.

The Examiner states that Koga discloses preparations comprising xylobiose and that Example 7 recites hydroxypropylmethylcellulose. *Id.*

A rejection under §102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. §706.02(a) ("For anticipation under 35 U.S.C. §102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). Importantly, each and every element of a claim must be set forth in the prior art reference for there to be anticipation. *See* M.P.E.P. §2131.

Applicants respectfully submit that hydroxypropylmethylcellulose has been excluded from the claim by virtue of the proviso, as discussed above. Because Koga only discloses hydroxypropylmethylcellulose, Koga does not disclose the film-forming agent as claimed. Accordingly, each and every element of claims 1-40, 161, and 162 is not disclosed by Koga.

Accordingly, Applicants respectfully request withdrawal of this rejection.

IV. Rejection under 35 U.S.C. §103(a)

To establish a *prima facie* case of obviousness, there must be some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of

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ordinary skill to modify or combine reference teachings with a reasonable expectation of success in obtaining the presently claimed invention. M.P.E.P. §§2143.01 and 2143.02.

Beck

Claims 1-4, 10-40, 161, and 162 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pub. No. 2002/0031483 ("Beck"). *Office Action* at pp. 3-5. Applicants respectfully traverse this rejection.

The Examiner supports the rejection by noting that Beck teaches a hair treatment composition comprising sugars such as trioses, tetroses, and pentoses, and film-forming cationic polymers. *Id.* at pp. 3-4. The Examiner also refers to Beck's disclosure of Polyquaternium 16. *Id.* at p. 4.

Applicants respectfully submit that the Examiner's rejection is based on the selection of isolated passages within Beck to arrive at the claimed invention, without any teaching or motivation to do so. For example, Beck teaches the use of sugars from trioses to hexoses without suggesting the desirability of compounds chosen from C₃-C₅ saccharides compared to C₆ saccharides, as required in M.P.E.P. §2143.01. ("The prior art must suggest the desirability of the claimed invention."). Thus, there is no basis for the specific selection of C₃-C₅ saccharides combined with polyquaternium 16 from the disclosure of Beck.

The Federal Circuit has cautioned against this particular type of hindsight reconstruction in *Kotzab*. 217 F.3d 1365 (Fed. Cir. 2000). The Federal Circuit recognized that "[m]ost, if not all inventions arise from a combination of old elements ... every element of a claimed invention may often be found in the prior art." *Id.* at 1369-

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1370. The *Kotzab* invention was directed to a process of controlling the temperature of an injection mold by using a single sensor. *Id.* at 1367. The PTO's rejection relied on two statements in a single prior art reference. *Id.* at 1371. The court found that the PTO impermissibly viewed these two statements "in the abstract," as opposed to being considered in the context of the entire reference. *Id.* at 1371. In cautioning against hindsight reconstruction, the court stated:

[A] rejection cannot be predicated on the mere identification in Evans of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

Id. (emphasis added).

Applicants respectfully submit that a similar hindsight analysis has occurred here. Just as in *Kotzab*, the Examiner has identified individual components in the specification, namely trioses, tetroses, and pentoses and polyquaternium 16, by using the Applicants' claims as the template. The *Kotzab* ruling makes clear that the Examiner's rejection must be founded "with no knowledge of the claimed invention." Beck does not teach this specific combination and none of the Examples in Beck list this particular combination. Applicants can only conclude that improper hindsight was used to fashion this rejection.

The Examiner commented that Applicants have not provided unexpected results with C3-C5 sugars as opposed to C6 sugars. *Final Office Action* at p. 7. Applicants respectfully submit that unexpected results are not required where a *prima facie* case has not been established.

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Accordingly, Applicants respectfully request withdrawal of this rejection.

Keil and Beck

Claims 1-40, 161, and 162 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,690,924 ("Keil") in view of U.S. Pub. No. 2002/0031483 ("Beck"). *Office Action* at pp. 56. Applicants respectfully traverse this rejection.

The Examiner states that Keil teaches hair treatment compositions "but does not teach the instant monosaccharides." *Id.* at p. 5. Thus, the Examiner relies on Keil for teaching trioses, tetroses, and pentoses and film-forming cationic polymers. *Id.*

The Examiner cites Beck for disclosing polyquaternium 16. Polyquaternium 16 is a polymeric quaternary ammonium salt, i.e., a cationic polymer. *See* International Cosmetic Ingredient Dictionary and Handbook, 8th ed., CTFA Scientific/Regulatory 2000.

Applicants respectfully submit that Keil teaches away from the combination of references. In the "Background" section, Keil teaches that cationic polymers are known to provide hair care action. *Id.* at col. 1, lines 18-20. However, they are disadvantageous in that they are absorbed on the hair, cotton fabric, and mucous membranes. *Id.* at lines 20-22. Thus, Keil teaches that the invention is "advantageously free of cationic polymers used up to now for hair care." *Id.* at lines 51-55. Specifically, Keil is directed to a hair treatment composition comprising at least one synthetic, film forming, nonionic or anionic hair fixing polymer or a natural film-forming hair fixing polymer. *Keil* at col. 1, lines 4-11.

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Based on Keil's teaching to avoid cationic polymers and to provide compositions "advantageously free of cationic polymers," one of ordinary skill in the art would not combine the cationic polyquaternium 16 of Beck with Keil's composition.

It is well settled that there is no suggestion to combine where the combination "would render the prior art invention.... unsatisfactory for its intended purpose." M.P.E.P. § 2143.01. Because Keil clearly teaches the disadvantages of cationic polymers and that its composition should be free of cationic polymers, the addition of polyquaternium 16 would defeat the purpose of Keil's composition.

Because there is no suggestion to combine the references, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of this rejection.

V. Conclusion

Applicants respectfully request the reconsideration and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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